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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,801	12/02/2003	Michael J. Tilley	309-002	4126

33354 7590 10/14/2008
ETHERTON LAW GROUP, LLC
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PHOENIX, AZ 85008

EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
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3726

MAIL DATE	DELIVERY MODE
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10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,801

Applicant(s)

TILLEY ET AL.

Examiner

Jermie E. Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 17 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (5,249,899).

Regarding claim 16, Wilson discloses starting a fastener (10), by a) using a shaft (20) having a bore (21); b) placing an amount of a tacky substance (i.e. adhesive, 31) on an end (14) of the fastener (10); c) inserting the end of the fastener (10) with the amount of tacky substance (31) into the bore (21); d) starting inserted fastener into a desired location; and e) removing the shaft (20) from the fastener (10).

Regarding claim 18, Wilson discloses the shaft (20) being inherently comprised of metal.

See column 3, line 60 – column 4, line 33, and figures 4-9 for further clarification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (3,788,537) in view of Hanny et al. (3,485,132). *See column 2, lines 1-66 and figures 1-5 for further clarification.*

Regarding claim 16, Fox discloses starting a fastener (44), by using a shaft (36) having a bore (30); inserting the end of the fastener (44) into the bore (36); starting inserted fastener into a desired location (60); and removing the shaft (2, 10, 36) from the fastener (44).

Regarding claim 18, it is inherent that the shaft (36) is comprised of metal.

Regarding claim 19, Fox discloses the fastener (44) being a roll pin.

Fox, however, does not disclose placing an amount of tacky substance on an end of the fastener.

Hanny discloses placing a tacky substance (26, 29) on an end of the fastener (see FIG. 7). *See column 5, line 47 – column 6, line 9, and figure 7 for further clarification.*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a tacky substance to end of the fastener of Fox, in light of the teachings of Hanny, in order to effectively provide a coating which aids in the attachment of the fastener to another component.

5. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (5,249,899).

Wilson discloses all of the claimed subject matter except for the fastener being a roll pin, or the tacky substance being grease or wheel bearing grease.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use grease such as wheel bearing grease because Applicant has not disclosed that using grease such as wheel bearing grease as the tacky substance provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with adhesive as the tacky substance because the fastener is effectively secured.

Therefore, it would have been an obvious matter of design choice to modify Wilson to obtain the invention as specified in claims 20 and 21.

Response to Arguments

6. Applicant's arguments filed 7/30/08 have been fully considered but they are not persuasive.

Applicants argue that Wilson does not disclose inserting the end of a fastener on which a tacky substance is placed into a bore of a starting tool.

In response, the Examiner maintains that shaft (20) has a bore (21) wherein the cavity engages the flats (14) of the fastener (14). Therefore, if the flats (14) are received in the bore (21) of the shaft (20) then it is clearly apparent that the inserted end of the fastener (14) on which a tacky substance (31) is received within the bore (21) of the tool. Although not shown in the figures, it is clear from the written description of Wilson at column 3, line 60 - column 4, line 11. The bore (21) of the shaft (20) surrounds and encompasses the head of the fastener (14) which contains the tacky substance (31). The bore (31) allows a projection (22) to register within second head

portion (13) of the fastener (14). In addition, it appears that Applicants are trying to argue that the tacky substance holds the fastener within the bore of the shaft, however, none of the claim limitations require that the tacky substance holds the fastener within the bore.

Applicants argue that Hanny teaches away from inserting the tacky end of the fastener into the bore.

In response, the Examiner maintains that Fox teaches inserting a fastener wherein the entire fastener is retained within the bore of the shaft. Fox, however, does not disclose the fastener having a tacky substance. Hanny discloses a fastener having a tacky substance located along the shaft and beneath the head of the fastener. Therefore, it would have been obvious to provide the fastener of Fox in the form of a fastener with a head having a tacky substance located along the shaft and underneath the head wherein the entire fastener is retained within the shaft of the bore of Fox prior to inserting the fastener into the parts, in order to effectively provide a coating which aids in the attachment of the fastener to another component. Also, Applicants appear to argue that which is not claimed, meaning the claims as written do not require the tacky substance being used to hold the fastener within the bore of shaft.

Applicants also argue that the adhesive in Wilson is intended to adhere the fastener into the desired location and does not adhere the fastener into the bore.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the tacky substance adhering the fastener in the bore) are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie E. Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3726

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/
Primary Examiner, Art Unit 3726

October 9, 2008